

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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In re appln: Stephen R. CARTER, et al. Conf. No. 4935

Serial No.: 09/615,726 Art Unit: 2654

OFFICE OF PETITIONS

Filed: July 13, 2000 Examiner: SPOONER, Lamont M.

For: A METHOD AND MECHANISM FOR THE CREATION,
MAINTENANCE, AND COMPARISON OF SEMANTIC ABSTRACTS

BOX RCE
Assistant Commissioner of Patents
Washington, DC 20231

**PETITION TO WITHDRAW FROM
ISSUE UNDER 37 CFR §1.313(c)(2)**

Applicant hereby petitions to withdraw from issue under 37 C.F.R. § 1.313(c)(2) in favor of the enclosed Request for Continued Examination (RCE) and Amendment. Applicant is in receipt of a Notice of Allowance and paid the issue fee on the above-referenced patent application on July 25, 2005.

This patent application incorporated by reference U.S. Patent Application Serial No. 09/512,963 (hereinafter "the '963 application"). The '963 application has not yet issued but is still pending before the U.S. Patent & Trademark Office, nor has it been published. At the time this patent application was filed, incorporation by reference of an unpublished, pending U.S. patent application was permissible to support any claimed subject matter. (If the '963 application had issued as a patent before this patent application, amending the specification of this patent application would not be necessary.)

During the course of prosecution of this patent application, the claims were amended to include features described in the '963 application, and supported only in this patent application as a result of the incorporation by reference of the '963 application.

On June 9, 2005, Examiner Spooner issued a Notice of Allowance in this application. It was around this date that the Applicant was made aware that the incorporation by reference of the '963 application – the only support for some features of the claims – would be insufficient to support the features of the claims that are described in the '963 application. In a telephone call with Examiner Spooner on July 5, 2005, the undersigned proposed an

Amendment After Allowance, amending the specification of the application to include specific material described in the '963 application. On July 20, 2005, after consulting with his Primary Examiner, Examiner Spooner indicated he and his Primary Examiner believed the amendment would be acceptable, and would consider it. Had Examiner Spooner indicated at that time that the Amendment would not be approved, the undersigned would have filed a Request for Continued Examination instead of paying the issue fee and filing an Amendment After Allowance.

The proposed Amendment After Allowance included the language from pages 11-17 of the '963 application, along with the related drawings: FIGs. 3-5G and 13. Other than renumbering the figures, figure reference numbers, and equations, the only other proposed inclusion was equations (3a), (3b), and (3c), support for which can be found on page 10 of the '963 application (numbered therein as equations (1a), (1b), and (1c)), along with supporting explanation of the equations. The undersigned noted that the proposed amendment replaces the one paragraph beginning on page 3, line 27 of the application with the text shown on pages 2-9 of the proposed Amendment After Allowance. No new matter was proposed to be added.

The Amendment After Allowance was transmitted to the Patent & Trademark Office on July 25, 2005, along with PTO Form 85B and the issue fee. On October 20, 2005, Examiner Spooner mailed a Response to the Rule 312 Communication, indicating that the amendment was disapproved. On November 14, 2005, the undersigned spoke with Examiner Spooner, who indicated that the only way to have the amendment considered was by withdrawing the application from issuance and filing a Request for Continued Examination. As the Applicant believes this amendment is important to the understanding of the claims, Applicant wishes to withdraw this case from issue, in order to have these amendments considered in the attached Request for Continued Examination and Amendment.

The Applicant also notes that 37 C.F.R. § 1.57 has changed the rules regarding incorporation by reference. Under this rule change, it appears that this application must be amended to explicitly set forth the incorporated subject matter from the parent application. 37 C.F.R. § 1.57 was added September 21, 2004, and became effective November 22, 2004. While the U.S. Patent & Trademark Office has indicated publicly that 37 C.F.R. § 1.57 will not be applied to applications filed before October 21, 2004, such limitation is not stated in the rule. Compare, for example, with 37 C.F.R. § 1.78, which states (in subparagraph (a)(2)(ii)(B)) that the new section does not apply to applications filed before November 29,

2000. 37 C.F.R. § 1.78 was added as part of the American Inventors Protection Act (AIPA) in 1999, and changed the rules regarding claiming priority, just as 37 C.F.R. § 1.57 has changed the rules regarding incorporation by reference. Accordingly, because 37 C.F.R. § 1.57 does not textually limit itself to applications filed on or after October 21, 2004, the rule could be applied to all applications, irrespective of their filing date.

According to the 37 C.F.R. § 1.57(c), “‘Essential material’ may be incorporated by reference, but only by way of an incorporation by reference to a U.S. patent or U.S. patent application publication ‘Essential material’ is material that is necessary to: (1) Provide a written description of the claimed invention” The Applicant understands that features of the claims are “essential material”. At no point during prosecution did Examiner Spooner indicate that the incorporation by reference of the ’963 application might be ineffective, nor was the Applicant otherwise aware that the incorporation by reference of the ’963 application might be ineffective. Thus, under 37 C.F.R. § 1.57, the specification should be amended to directly include the pertinent subject matter from the ’963 application.

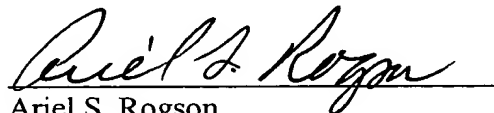
Applicant submits the petition fee of \$130 as set forth in §1.17(h).

It is understood that a new Notice of Allowance will be sent in due course if the application is deemed allowable.

Any deficiency or overpayment should be charged or credited to deposit account number 13-1703.

Respectfully submitted,

MARGER JOHNSON & McCOLLOM, P.C.

A handwritten signature in black ink, appearing to read "Ariel S. Rogson", is written over a horizontal line.

Ariel S. Rogson
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